

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following remarks is respectfully requested.

A. Status of the Claims And Explanation Of Amendments

Claims 1-22 were pending. At the outset, Applicants wish to thank the Examiner for the indication of allowable subject matter in claims 12, 15-18 and 20-21.

By this paper, claims 1, 10, 15 are cancelled. Also, claims 2-3, 5-8, 16, 18-20 are amended to depend from claim 23, instead of cancelled claims 1 or 15. Claims 11-14 are amended to depend from claim 25 instead of cancelled claim 10. In addition, grammatical changes have been made in claims 5-6, 17-18. Finally, new claims 23-28 have been added.

Support for new claim 23 is found throughout the application as originally filed, including original claims 1 and 15. Support for new claim 24 is found throughout the application as originally filed, including original claims 1 and 20. Support for new claim 25 is found throughout the application as originally filed, including original claims 1 and 10. Support for new claims 26-27 is found throughout the application as originally filed, including original claim 12. Support for new claim 28 is found throughout the application as originally filed, including original claim 21.

Claims 1-11, 13-14, and 19 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,572,248 to Okuchi et al. (“Okuchi”) in view of U.S. Patent No. 6,477,026 to Lemke (“Lemke”). Claim 11 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Okuchi and Lemke and further in view of U.S. Patent No. 5,473,697 to Ishihara (“Ishihara”).

B. Claims 11-14 and 25 Are Patentably Distinct From Okuchi and Lemke¹

New independent claim 25 has been presented which incorporates the claim elements of original claims 1 and 10. New claim 25 is patentably distinct from the references cited against previously pending claim 10 as discussed below.

Claim 25 recites:

A device for the automatic adjustment of a position of at least one headlight of a motor vehicle in relation to a bodywork by pivoting around at least one axis which is essentially parallel to a road surface, said device comprising

at least one actuator capable of pivoting said headlight;

at least one sensor integral with said motor vehicle; and

at least one electronic control system adapted to control the actuator with aid of information provided by the sensor, the electronic control system being analog and being fixed to or implanted in the actuator.

Okuchi is directed to an apparatus for automatically adjusting optical axis of vehicle headlights. The office action conceded that Okuchi fails to disclose the “type of control system.” [12/28/04 Office Action at p. 3]. For this feature, the Office Action relies on Lemke, which is directed to a single package solenoid having control circuit. The office action alleges that Lemke discloses the use of either analog or digital control circuitry at column 5, lines 24-25.

There are at least three problems with the “*prima facie*” case of obviousness allegedly laid out in the office action. First, the office action fails to provide any explanation why one of ordinary skill in the art at the relevant time would have been motivated to use analog

¹ The rejections of claims 2-9, and 16-22 are respectfully asserted to be moot. These claims have been amended to depend, directly or indirectly from new independent claims 23 and 24. These claims embody the claim elements of original claims 15 and 20, which had been found to be allowable. For at least similar reasons, these claims also are asserted to be allowable.

control circuitry with the Okuchi device. The Office Action has not provided any such motivation. Without that the rejection is flawed and must be withdrawn. *See* MPEP §2143.01

Second, Lemke is not analogous art and may not be relied upon in an attempt to make a *prima facie* showing pursuant to 35 U.S.C. §103. *See* MPEP 2141.01(a). Lemke is classified in class 361 (Electricity; Electrical Systems And Devices), subclass 152 (Systems for magnetizing, demagnetizing, or controlling the magnetic field Including particular drive circuit). It is classified as such because it deals with a solenoid used to actuate hydraulic valves to control the header of agricultural vehicles. By contrast, Okuchi is classified in class 362 (Illumination), subclass 464 (Supported By Vehicle Structure; Condition responsive). This is not at all similar to the classification of Lemke. Moreover, Lemke is very far afield from applicants' invention. The size of the element which the actuator acts on, the kind of actuator, its location in the vehicle, and the operating requirements are all vastly different. Accordingly, Lemke is neither in the field of applicant's endeavor nor reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Third, the office action improperly proposes to change the principle of operation of Okuchi and has not showed a reasonable expectation of successfully making those changes. Okuchi relies on digital components as the office action appreciates. By suggesting that a single component of Okuchi's device (i.e., the electronic control unit 20) should be changes to an analog component would change the operation of Okuchi's entire device. Moreover, no showing has been made of how an analog system could be inserted into Okuchi's device instead of the electronic control unit 20.

Accordingly, Applicants respectfully suggest that a *prima facie* case of obviousness has not been made out. Allowance of independent claim 25 and its dependent claims 11-14 is requested.

Appl. No. 10/634,029
Paper dated March 28, 2005
Reply to Office Action dated December 28, 2004

CONCLUSION

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. An early and favorable examination on the merits is requested. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED FOR THE TIMELY CONSIDERATION OF THIS AMENDMENT UNDER 37 C.F.R. §§ 1.16 AND 1.17, OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT NO. 13-4500, ORDER NO. 1948-4814.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: March 28, 2005

By:


Matthew K. Blackburn
Registration No. 47,428

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
3 World Financial Center
New York, NY 10281-2101
(212) 415-8700 Telephone
(212) 415-8701 Facsimile